

Appl. No. 10/627,558

Reply dated October 28, 2005

Reply to Office Action of July 28, 2005

REMARKS/ARGUMENTS

Claims 1-24 and 36-37 are presented for Examiner Sperty's consideration. Please cancel claims 25-35 as shown, without prejudice thereto and Applicants reserve the right to pursue the invention of non-elected/canceled subject matter via divisional application. No claims are amended by this paper and no new claims are submitted herewith.

Pursuant to 37 C.F.R. § 1.116, reconsideration of the present application in view of the following remarks is respectfully requested.

By way of Paragraph 3 of the Office Action mailed July 28, 2005 claims 1-24, 36 and 37 were again rejected under 35 U.S.C. §102(b) as allegedly being anticipated by and thus unpatentable over U.S. Pat. No. 6,169,045 to Pike et al. (hereinafter "Pike et al. '045"). The Office Action mailed July 28, 2005 stated these claims were rejected by providing a copy of the rejection made in the Office Action mailed January 13, 2005. This rejection is hereby **traversed** to the extent it may apply to the currently presented claims.

The invention as claimed in claim 1 provides a nonwoven web including at least one side which is abrasion resistant, has a surface roughness of at least 20 μm , and has a fuzz-on-edge value less than 1.0 mm/mm.

The Pike et al. '045 reference relates to a lofty filter medium comprising a nonwoven fiber web of crimped fibers that can be spunbond fibers, and the filter medium has a density between about 0.005 g/cm³ and about 0.1 g/cm³ (please see Abstract). As the Examiner has also noted, the Pike et al. '045 reference discloses that conjugate polypropylene/ polyethylene fibers can be used, and teach multilayer construction where individual layers can have different densities.

However, as the Examiner has also noted, the Pike et al. '045 reference is silent as to at least two elements of the Applicants' claims -- the surface roughness of at least 20 μm , and a fuzz-on-edge value less than 1.0 mm/mm. The reasoning stated in the Office Action mailed January 13, 2005 (and copied in the Office Action mailed July 28, 2005) was that Pike et al. '045 webs would inherently meet these two elements because it was made from the same materials and according to the same process.

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Applicants disagree with the Examiner's position. As stated in M.P.E.P. §2112, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." (citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)). Applicants again submit that neither the surface roughness element nor the fuzz-on-edge value element has been shown to necessarily flow from the Pike et al. '045 disclosure.

According to the teachings of the Pike et al. '045 disclosure, the process for forming those webs teaches that the fibers are to be deposited directly onto the forming surface, also called a foraminous forming surface in the Examples of Pike et al. '045 (please see Summary, Examples at column 9 beginning line 24, and the process description cited by the Examiner at column 6 beginning line 34). In contrast, in the process for forming the nonwoven of the invention, the fibers are specifically not deposited directly onto the forming surface, but instead are formed onto a liner material that has itself been placed onto the forming surface. After the fibers for the nonwoven web are deposited onto the liner, the liner and nonwoven web are bonded, and the liner is removed from the nonwoven web. Please see Applicants' specification Summary at page 2 lines 22-30, Detailed Description at page 12 lines 12-33, and page 14 line 25 through page 15. Therefore, Applicants again respectfully submit that the Examiner's assertion that the materials of Pike et al. '045 are made by the same process is simply not correct.

Furthermore, Applicants again wish to direct the Examiner's attention to the portion of their specification describing Example and Comparative 2 nonwoven web materials (please see pages 23-26). For the purposes of the 35 U.S.C. §102(b) rejection over Pike et al. '045, note the Comparative 2 material is similar to the Pike et al. '045 materials at least because each is a conjugate fiber spunbond web formed by depositing the fibers directly onto the forming surface, instead of forming onto a liner material, bonding at least partially to the liner material, then having the liner material removed, as taught by the Applicants. In this regard, the information in the Applicants' specification in Tables 2 and 3 (page 26) is relevant to further show that an assumption of inherency as to the elements of surface roughness and fuzz-on-edge value is not correct. As shown in Table 2, two pieces

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of the Comparative 2 material were tested and had fuzz-on-edge values, as reported by the average PR/EL measurement, of about 1.5 and 2.2 mm/mm, whereas the claims require the fuzz-on-edge value to be less than 1.0. In addition, Table 3 shows that the average surface roughness measurement Sa for Comparative 2 material was 17.9, whereas the claims require the surface roughness of at least 20 microns.

By way of Paragraph 5 of the Office Action mailed July 28, 2005, claims 1-13 and 36 were again rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by and thus unpatentable over U.S. Pat. No. 5,605,749 to Pike et al. (hereinafter "Pike et al. '749"), or alternatively under 35 U.S.C. § 103(a) as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over Pike et al. '749. The Office Action mailed July 28, 2005 stated these claims were rejected by providing a copy of the rejection made in the Office Action mailed January 13, 2005. This rejection is hereby **traversed** to the extent it may apply to the currently presented claims.

The Pike et al. '749 reference relates to an active agent impregnated nonwoven (please see Abstract). As the Examiner has noted, the Pike et al. '749 reference discloses that conjugate fibers can be used, a can have a density between about 0.01 g/cm³ and about 0.1 g/cm³.

However, the Pike et al. '749 reference (as with the Pike et al. '045 reference discussed above) does not appear to disclose at least two elements of the Applicants' claim 1 — the surface roughness of at least 20 µm, and a fuzz-on-edge value less than 1.0 mm/mm. The Office Action/rejection noted that the Pike et al. '749 reference does state the web can have abrasion resistance, but the Examiner did not show the Pike et al. '749 reference to either explicitly or implicitly/inherently disclose the required surface roughness.

In addition, the Examiner noted that the Pike et al. '749 reference mentions low lint at column 5 lines 44-47 and stated that low lint anticipated the required fuzz-on-edge value, or, alternatively, would obviously have been provided by preparing the web in accordance with the specification and the web's intended use. Applicants again disagree with the Examiner's positions. The disclosure of low-lint at column 5 lines 44-47 of Pike et al. '749 does not appear to be more than a statement recognizing that continuous fiber webs are

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less likely to lose fibers (less likely to "lint") than short fiber (staple fiber) webs. Applicants point out that that both their Example and Comparative 2 materials are continuous fiber webs, yet, as discussed above, the Comparative 2 material does not meet the required fuzz-on-edge value. In addition, Applicants point out that the Pike et al. '749 materials are disclosed to be produced in a similar fashion to those of Applicants' Comparative 2 material and those of the Pike et al. '045 reference discussed above; that is, by depositing the fibers directly onto a foraminous forming surface (please see Pike et al. '749 at column 9 lines 20-25). Therefore, Applicants respectfully submit that the Examiner's assertion that the low lint comment in Pike et al. '749 anticipates or makes obvious Applicants' required fuzz-on-edge value is simply not correct.

The remarks above are substantially similar to those provided by Applicants in their paper filed May 13, 2005. The Office Action mailed July 28, 2005 responded to Applicants' May 13, 2005 remarks by stating (in Paragraph 7) that the Examiner concludes, despite the differences in production processes the Applicants have shown between the cited Pike et al. references and Applicants' process, that the "similarities are sufficient enough" to deduce inherency of the properties. In Paragraph 8 the Office Action stated that no appreciable difference was seen between the cited art and Applicants' description of forming on a liner that would render the Examiner's conclusion of inherency unfounded, and it was also stated that the Applicants' liner may be analogous to the first layer of a multilayer product in the cited reference. And, finally, in Paragraph 9 the Office Action stated that Applicants' arguments were based on self-concocted properties rather than on structure and were therefore weak arguments.

Applicants respectfully submit that reasoning stated by the remarks in Paragraphs 7-9 of the Office Action mailed July 28, 2005 does not uphold a proper conclusion of inherency of the alleged inherent properties of Applicants' claims. The standard as stated in M.P.E.P. §2112 is that the allegedly inherent characteristics necessarily flow from the art. Or, as further stated in M.P.E.P. §2112 and citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

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Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

(Emphasis is added). Applicants submit that a substantial similarity as stated in the Office Action is not sufficient to make clear that the missing elements are necessarily present.

Furthermore, inherency is not a non-rebuttable presumption and Applicants submit that they have provided sufficient evidence to rebut the presumption that the two missing claims elements are allegedly inherent in the cited art. Applicants submit that the distinctions described hereinabove vis-à-vis the processes taught in the cited art and in their Application show that Applicants' material is made by a substantially dissimilar process than the art materials. Specifically regarding the statement in Paragraph 8 of the Office Action mailed July 28, 2005 to the effect that no appreciable difference was seen between the art process and Applicants' description of forming onto a liner, Applicants point out that their material being formed onto a liner and bonded at least partially to the liner, and then removed from the liner to which it is bonded, is significantly different than the process taught in the cited references wherein the material is deposited directly onto a forming surface and not a liner, and not bonded-to-then-removed-from the surface onto which it is formed. Applicants submit that the material surface characteristics formed by these two substantially dissimilar processes should not be presumed to be inherently identical. This same reasoning applies to the statement in Paragraph 8 of the Office Action mailed July 28, 2005 to the effect that the liner in Applicants' process may be analogous to the first layer of a multilayer product taught by the reference, because the reference does not teach bonding-then-removing of that first layer.

Finally, Applicants have pointed to the evidence from their own specification that further rebuts the alleged inherency of the two missing claims elements. As stated above, the testing evidence in the Applicants' specification demonstrates that the Comparative 2 material, which, like the Pike et al. materials, is formed directly onto a forming surface rather than being formed onto a liner, bonded to the liner, and then having the liner removed, does not meet the required surface roughness and a fuzz-on-edge elements. Because a Comparative material formed in a process that is similar to the cited art process fails to meet these two requirements, Applicants respectfully submit that it is not

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reasonable to presume that these two requirements are inherently disclosed in the prior art.


For the reasons stated above, Applicants respectfully submit that neither the Pike et al. '045 reference nor the Pike et al. '749 reference teach all of the parameters or elements of Applicants' claims as presented, and further submit that allegedly inherent characteristics do not necessarily flow from the teachings of these cited Pike et al. references, and still further submit that they have shown these elements may not be presumed to be inherent from the references. Therefore, Applicants respectfully submit that the rejection of their claims under 35 U.S.C. §102(b) (alternatively under 35 U.S.C. § 103(a)) should be withdrawn. For the reasons stated above, it is respectfully submitted that all of the claims are in form for allowance.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: 770-587-8908.

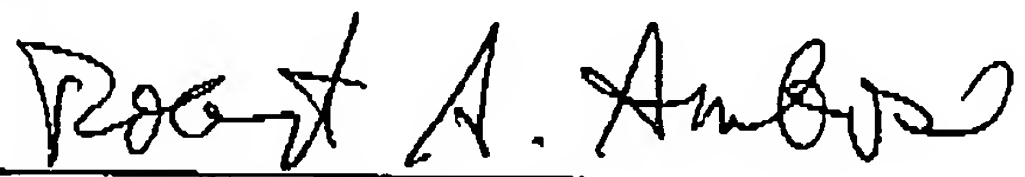
Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I, Robert A. Ambrose, hereby certify that on October 28, 2005, this document is being faxed to the United States Patent and Trademark Office, central facsimile machine at (571) 273-8300.

By: 
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